

REMARKS

The present application relates to a pressure sensitive adhesive product.

Claims 1, 3 - 7 and 9 - 10 are pending. Claims 1, 3 - 8 and 10 were previously rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over "Toda" (JP 05-302026) in view of "Watabe" (JP 05-059267). Claim 9 was previously rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Toda in view of Watabe in claim 1, and further in view of "Hirose" (US Patent No. 5,631,082).

Claim 11 has been added above. Support for this amendment is found, for example, at page 14, line 30 to page 15, line 20 of the specification.

Claims 5 and 6 are canceled.

Upon entry of the above Amendment, claims 1, 3, 4, 7, and 9 - 11 will be pending.

On page 5 of the previous Office Action, claims 1, 3 - 8 and 10 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Toda in view of Watabe, for reasons of record. (Claim 10 is understood to be included in this rejection, because it was included in the detailed action as supporting this rejection. See first full paragraph on page 7 of the Office Action).

On page 7 of the Office Action, claim 9 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Toda in view of Watabe in claim 1, and further in view of Hirose.

The Examiner acknowledged that neither Toda nor Watabe explicitly teach that the compositions may be applied to the specific support materials as required by instant claim 9; however, the Examiner asserted that such an intended use would have been obvious based on the teachings of Hirose, because Hirose teaches silicone-based pressure-sensitive materials which

are comprised of the same principal ingredients as Toda, namely, a hydrolyzable silaneterminated polyether, tackifier, curing catalyst and filler. Thus, the Examiner concludes that it would have been obvious to coat the compositions, as taught by Toda, onto the thin film and metal foil substrates since Hirose teaches that silicone-based pressure sensitive adhesives may be prepared from compositions which have markedly similar base ingredients.

Applicant respectfully submits herewith Declaration evidence of unexpectedly superior results that rebut any *prima facie* case of obviousness the Examiner has alleged.

Applicant has already presented arguments and evidence regarding the unexpected effect of the combination of components (A), (B), and (C) in the response filed on June 5, 2009. The effect is indicated, for example, by comparison between Example 1 or Example 2 with Comparative Example 2, which corresponds to the composition of Toda.

In the paragraph bridging pages 3 and 4 of the previous Office Action, the Examiner maintained that the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range.

In response, Applicant submits herewith a Declaration Under 37 C.F.R. § 1.132, which points to evidence of unexpectedly superior results that are submitted to support the scope of the present claims.

Referring to Table 1 on page 4 of the Declaration, the compositions of Experiments 1 to 6 in the Declaration contain various amounts of components (A), (B) and (C). Experiment 5 corresponds to Example 1 of the present application.

A comparison between Experiments 2, 4 and 5 indicates that the pressure sensitive adhesive composition has a sufficient adhesive strength even when the amount of (B) component is 20 or 10 parts by weight relative to 100 parts by weight of (A) component.

A comparison between Experiments 2 and 1 or Experiments 4 and 3 indicates that the pressure sensitive adhesive composition has sufficient adhesive strength even when the amount of (C) component is 40 parts by weight relative to 100 parts by weight of (A) component and (B) component in total.

Therefore, it should be clear that the claimed ranges are not too broad relative to Applicant's showing of unexpected results.

Further, it should also be noted that the amount of hydrolyzable silyl groups also affects the adhesive strength. In the Office Action of June 25, 2009 (page 5), the Examiner wrote:

"Therefore, it is submitted by the Examiner that a person having ordinary skill in the art would have expected an increase in adhesive strength when employing component (B) which has hydrolyzable silyl groups, when compared to compositions which do not have such groups present."

Referring to Tables 1 and 2 on pages 5 and 6 of the Declaration, Applicant respectfully submits that Comparative Example 1 shows that the component which does not have hydrolysable silyl group may provide at least equal or even a higher adhesive strength compared to Experiment 6. Too many hydrolyzable silyl groups in component (B) adversely affect the adhesive strength, which is also clear from the comparison between Experiments 5 and 6.

Thus, it should now be clear that a combination of the polymer (A) having a higher number average molecular weight and more hydrolyzable silyl groups, the polymer (B) having a lower number average molecular weight and less hydrolyzable silyl groups, and the tackifier resin (C) provides an unpredictably high adhesive strength, when the three components are blended in specific amounts within the claimed ranges.

Next, Applicant respectfully submits that there is no teaching, suggestion, motivation, or other reason to combine Hirose with the cited references.

Hirose discloses a tape or sheet form pressure-sensitive adhesive material which comprises a substrate and a pressure-sensitive adhesive layer. Hirose teaches that the substrate is obtained by curing a curable resin composition comprising (A) an organic elastomeric polymer having at least one silicon-containing group which is crosslinkable, (B) a curing catalyst and (C) optionally, a tackifier resin. See Abstract.

It seems the Examiner misinterprets Hirose.

The curable resin composition is used to obtain a cured sheet to be used as the substrate, not the adhesive layer. In Examples of Hirose, it is explained that the curable resin composition was coated on a silicone releasing paper, heated and cured to obtain a substrate (col. 10, lines 34 to 39).

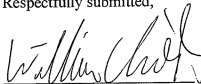
Accordingly, there is no motivation to combine Hirose and Toda. Thus, the rejection of claim 9 has been overcome.

In view of the above, Applicant respectfully submits that claim 1 and claims dependent thereon are non-obvious over the cited references. Reconsideration and withdrawal of the § 103 obviousness rejections are respectfully requested.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the local, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William Childs", written over a horizontal line.

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